

REMARKS

As a preliminary matter, Applicant traverses the outstanding Office Action as still being non-responsive. The Examiner has not effectively responded to Applicants' arguments detailing how the outstanding rejections are deficient under the requirements of both of Sections 2143.01 and 2143.03 of the MPEP.

For example, the Examiner has never challenged the fact that none of the cited references actually teaches or suggests to set the frequencies of the oscillator and the filter equal to one another, as featured in the present claims. Instead, the Examiner still insists that the cited prior art may be combined and modified into something allegedly equivalent to these features of the present invention. The Examiner has even provided many lengthy explanations for how he can personally derive such features from the modified art references. Whether or not such explanations are even correct (which Applicants do not concede), they still fail to satisfy the express requirements of Section 2143.01 of the MPEP.

The Examiner's lengthy explanations (again, only if correct) serve to establish nothing more than the *possibility* of combining and modifying the prior art to reach the present claims. Section 2143.01 though, expressly forbids obviousness combinations and modifications from being justified solely on the basis that it is possible to do so. Section 2143.01 still requires that the art references themselves (absent any extrinsic evidence on the record) affirmatively teach or suggest to make the exact combinations and modifications proposed by the Examiner. In the present case, however, the Examiner has never cited to one teaching or suggestion in any of the cited references

to make the lengthy derivation he proposes. Without any such motivation clearly indicated within the art itself, the only possible motivation to make the Examiner's complex derivation comes from the present Application itself, which is the definition of an impermissible use of hindsight.

The burden to overcome a *prima facie* case of obviousness does not shift to Applicants until the Examiner can demonstrate – without the advantage of Applicants' own Disclosure – where the art itself not only shows how the Examiner's personal derivation is possible, but where the art actually teaches or suggests to attempt such a derivation in the first place. Because no such teachings or suggestions have ever been submitted on the record, the outstanding rejections are still deficient for at least these reasons, and should be withdrawn.

Claims 1, 4-8, and 11-14 again stand rejected under 35 U.S.C. 103(a) as being unpatentable over Applicants' Admitted Prior Art ("the AAPA") in view of Horn ("Basic Electronics Theory"), Benes (U.S. 4,817,430), and Storch (U.S. 2,980,872), and claims 2-3 and 9-10 again stand rejected under 35 U.S.C. 103(a) as being unpatentable over the AAPA, Horn, Benes, and Storch, and further in view of the previously cited Gibilisco reference. Applicants once again respectfully traverse these rejections for at least the reasons of record, those discussed above, and as follows.

The repeated case for obviousness still fails to follow any of the required standards to consider claims for patentability. The Examiner's statement (page 3 of the outstanding Office Action, lines 20-23) that "Horn is the glue that provides the motivation *to filter out undesirable signals* which in the case of a sine wave generator is

the harmonics and Benes is merely one example of many that teaches that *filters can be used to filter out undesirable frequencies*” is highly illustrative of the primary flaw in the rejection. (Emphasis added). Not one claim term or phrase of the present invention recites a process limitation of “filtering out undesirable signals.” The present claims are all apparatus claims, and the Examiner is required to consider the specific structural and material characteristics of the claimed apparatuses, and not merely the *results* they may or may not generally achieve.

The fact that the present claims may “filter out undesirable characteristics” is irrelevant to the deficiencies in the rejection. All of the present claims feature at least one frequency filter, and every frequency filter, by definition, will operate to “filter out frequencies,” whether undesirable or not. The patentability of the present invention is not dependent on the mere *function* of the filter, which is not at issue. It is the actual operating parameters, settings, and interrelationship of the present filter with other elements of the invention that establishes the novelty and nonobviousness of the present invention. The Examiner’s extreme position, however, would render unpatentable any claim that recited a frequency filter, because such a filter will always “filter out frequencies.”

In effect, the Examiner is requiring that all filters must be equivalent, regardless of their settings, operating parameters, or interrelationship with other elements. According to the Examiner’s stated rationale, a coffee filter and a fishing net will always be equivalents, because both serve to filter out “undesirable” elements from water. The two items have no possible uses in common though. One skilled in the art, through

hindsight, may even be able to derive how one such item could be derived from the other. But such a derivation still would not render one patentably obvious from the other.

Applicants therefore once again respectfully request that the Examiner focus his attention on the actual features and limitations recited in the present claims, and not merely the possible results of utilizing such features. The present claims all feature, in one form or other, that the frequencies of the filter and oscillator are set to be equal. No single prior art reference cited by the Examiner has ever taught or suggested such a specific relationship between these two particular elements in the present invention. The Examiner must either show where such a specific relationship is taught or suggested, or withdraw the rejection.

To date, however, the Examiner has only cited Benes as allegedly teaching or suggesting such features of the present invention. As repeatedly pointed out to the Examiner though, Benes expressly requires that the frequencies of its filters and oscillator are not equal. In fact, one is *three times* the other. The Examiner appears to attempt to avoid this clear discrepancy from Benes by asserting how “Benes is merely one example of many that teaches that filters can be used to filter out the undesirable frequencies.” This statement, however, is clearly erroneous. The Examiner is restricted to the record at hand, and the “many references” to which the Examiner refers simply do not appear on the record. Benes is simply inapplicable to the features of the present invention for which the reference is cited. The asserted cases for obviousness are therefore still deficient.

Furthermore, Applicants traverse the Examiner’s claim of “Official Notice” stated on page 3 of the outstanding Office Action, line 5. As discussed above, Applicants

dispute the breadth at which the Examiner finds all filters to be equivalents. The Examiner is required to submit clear objective evidence on the record that supports the claim of Official Notice, or the claim must be withdrawn. The objective evidence must actually clearly teach or suggest the equivalence of the two elements for the particular application featured in the present claims, or the claim to Official Notice must be withdrawn. As also discussed above, evidence that both elements can merely be “used as filters” will not justify the Examiner’s claim. The evidence must show that the two are actually equivalent in the same particular application as in the present invention.

Additionally, despite the fact that *prima facie* obviousness still has not been established against the present claims, even such *prima facie* cases would have been long overcome in this case on rebuttal. Even a properly established obviousness rejection can be overcome by demonstrating how the present claims achieve advantages over all of the cited prior art references, taken alone or together. The Examiner has never challenged the clearly established advantages of the present claims over the prior art.

While the Examiner has focused his attention only upon the issue of “filtering out undesirable frequencies,” the Examiner has never challenged the additional advantage of the present invention – one even recited in the claims – of reducing jitter in the finally output signal. And, because the Examiner has never even asserted that any combination of the cited references could realize these same advantages as in the present invention, the obviousness rejections should have to be withdrawn at least on rebuttal. These particular advantages of the present invention are clearly established on the record, and undisputed.

Lastly, and although no further amendments to the claims are necessary for at least the reasons discussed above and previously, Applicants submit some further clarifying amendments to the independent claims. These amendments are submitted solely for the purpose of advancing prosecution, which has clearly stalled in this case. The Examiner can see that some subject matter from claim 14 has been amended herein to avoid even the Examiner's overly broad interpretation, as demonstrated on page 3, lines 7-12 of the Office Action. The Examiner's assertion that the claim features were "not well-defined" is incorrect. When read in light of the present Specification, which is the correct standard of review, this claim language was easily understood by one of ordinary skill in the art.

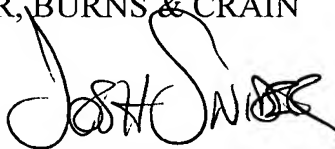
Nevertheless, in the interest of expediting prosecution only, Applicants have amended the grammar of this portion of the claims to be more easily understood even without the benefit of the present Specification. The Examiner should easily see that the new grammar for these features of claim 14 is substantively equivalent to the language as it previously appeared, and when it was considered in light of the Specification. And in one more hope of advancing prosecution, these same features have been incorporated into the other independent claims as well. All of the claims should therefore be in condition for immediate allowance for at least these, or for any of the foregoing, reasons.

For all of the foregoing reasons, Applicant submits that this Application, including claims 1-14, is in condition for allowance, which is again respectfully requested. The Examiner is invited to contact the undersigned attorney if an interview would further expedite prosecution.

Respectfully submitted,

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